

Remarks

Claims 1-20 are pending in the application. Claims 1-7 are rejected, and the Examiner has withdrawn from consideration claims 8-20. By this paper, claims 1 and 8 are amended. Based on the following, consideration of the amended claims, and reconsideration of the remaining claims, are requested.

Elections/Restrictions

On May 6, 2004, the Examiner mailed an Office Action that included a restriction requirement. The Examiner indicated that the application contained three patentably distinct species: Species A, which was illustrated in Figures 1-10, Species B, which was illustrated in Figures 11-18, and Species C, which was illustrated in Figures 19-23. On May 14, 2004, Applicant filed a response to the restriction requirement, electing, without traverse, to prosecute Species A. Applicant then stated that claims 1-15 read on Species A. In the recent Office Action mailed July 2, 2004, the Examiner indicates that only claims 1-7 read on the elected embodiment. The Examiner then states that claims 8-20 are withdrawn from further consideration.

As indicated in Applicant's reply of May 14, 2004, the election of Species A was without traverse; however, Applicant respectfully disagrees with the Examiner, and reasserts that claims 8-15 also read on Species A. First, it was the Examiner who defined Species A as being illustrated in Figures 1-10. A review of claims 8-15 clearly indicates that these claims read on the embodiment illustrated in Figures 1-10. In addition, the MPEP states that "[w]here the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required." MPEP § 806.03, 8th ed., Rev. 2.

Reviewing claims 1 and 8, for example, yields the conclusion that each of these claims defines the same essential characteristics of a single disclosed embodiment—the embodiment illustrated in Figures 1-10. Of course, the embodiment shown in Figures 1-10 is used as an example, and does not imply that claims 1 and 8 are limited to this embodiment. Similarly, claims 9-15 also read on Species A defined by the Examiner. Accordingly, examination of amended claim 8 and claims 9-15 is respectfully requested.

Claim Rejections—35 U.S.C. § 102

The Examiner rejected claims 1 and 4-7 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,986,188 (Karp et al.). The MPEP states that "'a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.'" MPEP § 2131, 8th ed., Rev. 2 (citation omitted). The MPEP further states that "'the identical invention must be shown in as complete detail as is contained in the... claim.'" *Id.* (citation omitted). Because claims 1 and 4-7 each contain elements which are neither expressly nor inherently described in Karp et al., it is submitted that none of these claims is anticipated by that reference.

By this paper, claim 1 is amended to more particularly point out and distinctly claim the subject matter of the invention. For example, amended claim 1 recites a cage-nut assembly comprising a cage structure having a flat base. Further, amended claim 1 recites "the flat base being generally planar, thereby facilitating surface attachment of the cage structure to a corresponding generally flat surface." No such elements are expressly or inherently described in Karp et al. For example, Karp et al. describes a clinch nut, which, as illustrated in Figures 1-3, includes a base plate 15. The clinch nut also includes a grip member 10 having a cylindrical insert portion 12 with longitudinal surface serrations 13. (Col. 1, ll. 69-71.) At one end of the insert portion 12, the grip member diverges to form the base plate 15. (Col. 2, ll. 1-3.) In order to use the clinch nut, "the serrated insert portion 12 of the grip member is pressed into a hole in an element through which it is desired to attach a screw to a nut." (Col. 2, ll. 38-40.)

It is clear both from the drawing figures, as well as the text of the specification, that Karp et al. does not expressly or inherently describe a flat, generally planar base that facilitates surface attachment of a cage structure to a corresponding generally flat surface, as specifically recited in amended claim 1. Further, Karp et al. does not describe in as complete detail the identical invention as contained in amended claim 1. Therefore, with regard to Karp et al. and amended claim 1, the MPEP definition of anticipation is not met.

Amended claim 1 is the base claim for claims 4-7. Each of these dependent claims contains all of the limitations of amended claim 1, as well as additional limitations which further

distinguish it from the cited reference. Therefore, with regard to Karp et al. and claims 4-7, the MPEP definition of anticipation is not met.

An examination of amended claim 8 leads to the same conclusion reached with regard to amended claim 1. Amended claim 8 also recites a cage structure having a flat base that is generally planar and facilitates surface attachment of the cage structure to a corresponding generally flat surface. No such elements are expressly or inherently described in Karp et al. Amended claim 8 is the base claim for claims 9-15. Each of these dependent claims contains all of the limitations of amended claim 8, as well as additional limitations which further distinguish it from the cited reference. Therefore, with regard to Karp et al. and claims 8-15, the MPEP definition of anticipation is not met.

Claim Rejections—35 U.S.C. § 103

The Examiner rejected claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over Karp et al., and further in view of U.S. Patent No. 6,146,071 (Norkus et al.). The MPEP states that "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so...." MPEP § 2143.01, 8th ed., Rev. 2. Applicant respectfully submits that there is no teaching, suggestion, or motivation to combine Karp et al. with Norkus et al., and therefore, the combination is not properly relied upon. For example, Norkus et al. describes a caged nut assembly for attachment to a frame that includes a channel. Specifically, a channel 38 is defined by an outer wall 42 and an inner wall 44. (Col. 4, ll. 18-20.) Further, the outer wall 42 has a slot 46 "so that a male fastener engaging bore 16 can slide therein as caged nut assembly 10 slides within channel 38." (Col. 4, ll. 22-24.)

If the clinch nut of Karp et al. is used in such a channel, one of two things will occur: either the serrations 13 on the insert portion 12 will bite into the sides of the channel, thereby inhibiting sliding movement as specifically desired by Norkus et al., or conversely, if the channel opening is large enough to provide a sliding fit, the serrations 13 will not bite into the material surrounding the channel, and therefore, the serrated insert portion 12 will be rendered unsatisfactory for its intended purpose. Similarly, modifying the clinch nut of Karp et al. to remove the grip

member 10 and replace it with a flat base so that it would function effectively inside a channel, would also render the clinch nut of Karp et al. unsatisfactory for its intended purpose. The MPEP is very clear when it states that a modification to a device that renders it unsatisfactory for its intended purpose indicates a lack of suggestion or motivation to make the modification. MPEP § 2143.01, 8th ed., Rev. 2.

Therefore, there is no teaching, suggestion, or motivation to combine Karp et al. with Norkus et al., particularly since modifying either device to effect a combination with the other, would render it unsatisfactory for its intended purpose. This analysis applies with equal force to claims 2 and 3, as well as the other pending claims. In rejecting claim 3, the Examiner relied upon Karp et al. and Norkus et al., as well as U.S. Patent No. 4,074,011 (Teramae et al.). As noted above, there is no teaching, suggestion, or motivation to combine Karp et al. and Norkus et al., and claim 3, therefore, is not obvious in light of the cited references. Accordingly, allowance of each of the pending claims, including claims 8-15, is requested.

Respectfully submitted,

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